

**REMARKS**

**General Remarks**

Claims 1-13 are all the claims currently pending in the present application.

Applicants note that the Examiner has failed to acknowledge Applicants' claim to foreign priority under 35 U.S.C. § 119, submitted on December 24, 2003, and the receipt of the certified copy of the priority document, submitted with the parent application (U.S. Application 09/836,388, now U.S. Patent No. 6,709,088) on August 8, 2001. Therefore, Applicants respectfully request that the Examiner acknowledge Applicants' claim to foreign priority and the receipt of the certified copy of the priority document in the next Office correspondence.

Claim Rejections. Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hayakawa, U.S. Patent No. 5,907,336 ("Hayakawa"), in view of Matsui et al., U.S. Patent No. 5,896,143 ("Matsui") and Matsushashi, EP 0786351 ("Matsushashi"). Claims 5-6 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hayakawa, in view of Sarmast, U.S. Patent No. 6,536,865 ("Sarmast"). Claims 1-5 and 7-10 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hayakawa, in view of Matsui and Sarmast. Applicants respectfully traverse these rejections as discussed below.

Claim Rejections. Claims 11-13 stand objected to. The Examiner indicates that Claims 11-13 contain allowable subject matter and would be allowed if rewritten into independent form, including all the limitations of the claims from which they depend. Applicants respectfully request that the rewriting of these claims be held in abeyance until the Examiner has considered Applicants' arguments regarding Claim 5 from which Claims 11-13 depend.

**RESPONSE UNDER 37 C.F.R. § 1.116**

U.S. Application No. 10/743,780

**Q79166**

Interview. A telephone interview was conducted with the Examiner on November 15, 2004. A Statement of the Substance of the Interview follows.

**Statement of the Substance of the Interview**

At the interview conducted on November 15, 2004, the Examiner indicated that the objection to Claims 11-13, noted on the PTOL-326 mailed with the current Office Action, is an objection based on the dependence of Claims 11-13 on a rejected base claim. The Examiner further indicated that Claims 11-13 contain allowable subject matter and would be allowed if rewritten into independent form, including all the limitations of the claims from which they depend.

**Hayakawa, Matsui, and Matsushashi**

Regarding the Examiner continuing rejection of Claims 1 and 2 over Hayakawa, Matsui, and Matsushashi, Applicants respectfully submit that the arguments previously presented in Applicants' 1.111 Amendment of July 29, 2004 continue to apply.

In response to these arguments, in the current Office Action, the Examiner asserts that Applicants' arguments that the Matsushashi disclosure of stopping the printing operation of the printer is equivalent to switching to a printing mode in which ink is not discharged into the ink-receiver holes, as recited in Claim 1, are not persuasive. (Office Action, p.9). The Examiner asserts that stopping printing and "non-printing" are printing modes as evidenced by the Abstract of Takahashi, U.S. Patent No. 4,558,332 ("Takahashi"). In addition to the arguments previously presented in Applicants' July 29 response, Applicants note that the Abstract of Takahashi fails to

**RESPONSE UNDER 37 C.F.R. § 1.116**

U.S. Application No. 10/743,780

**Q79166**

teach or suggest that stopping printing or “non-printing” are printing modes. The Abstract of Takahashi merely refers to a “non-print mode” of an ink-jet nozzle.

The reference in Takahashi to a “non-print mode” as a period during which printing does not occur, in contrast to a “print cycle,” during which printing does occur (Col 1, lns. 42-44), does not suggest that stopping printing or non-printing are considered as printing modes. On the contrary, Takahashi’s use of the phrase “non-print mode,” as contrasted with “print cycle,” suggests that stopping printing or “non-printing” are not, in fact, printing modes.

Therefore, in view of the above, Applicants submit that a reasonable combination of Hayakawa, Matsui, and Matsubishi fail to teach or suggest all the limitations of Claim 1 and 2 of the present invention and respectfully request that the §103(a) rejection thereof be reconsidered and withdrawn.

**Hayakawa, Matsui, and Sarmast**

Regarding the Examiner’s rejection of Claims 1-5 and 7-10 over Hayakawa, Matsui, and Sarmast and the Examiner’s rejection of Claims 5-6 over Hayakawa and Sarmast, Applicants respectfully submit that Sarmast is not available as a prior art reference against the present invention.

The issue date of Sarmast is March 25, 2003 and the publication date of Sarmast is January 30, 2003, both of which are after the original filing date of the parent (U.S. Application No. 09/836,388, now U.S. Patent No. 6,709,088) of the present application. Further, the U.S. filing date of Sarmast is July 25, 2001, which is also after the original filing date of the parent of

**RESPONSE UNDER 37 C.F.R. § 1.116**

U.S. Application No. 10/743,780

**Q79166**

the present application. Therefore Sarmast is unavailable as a prior art reference under 35

U.S.C. § 102 (a), (b), (d), or (e).

Therefore, without commenting on the substantive merits of the Examiner's rejections, Applicants respectfully request that the §103(a) rejections of Claims 1-5 and 7-10 over Hayakawa, Matsui, and Sarmast and of Claims 5-6 over Hayakawa and Sarmast be reconsidered and withdrawn.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

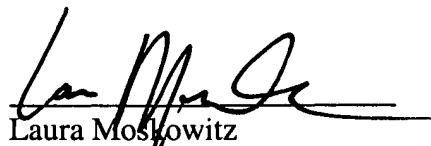
SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: January 21, 2005

  
Laura Moskowitz  
Registration No. 55,470